

### **REMARKS**

Applicant respectfully requests reconsideration. Claims 1-19 and 49 were previously pending in this application. Applicant has canceled claims 7, 8 and 17-19 by this amendment without prejudice or disclaimer. Applicant has amended claims 1, 9, 10, 13, 14, and 49 herewith. Support for the claim amendments can be found throughout the specification, the figures, and the claims as originally filed, for example, in the paragraph beginning on page 3, line 9, and in the paragraph beginning on page 18, line 18, and in Figure 3. As a result, claims 1-6, 9-16 and 49 are pending for examination with claims 1, 14, and 49 being independent claims. No new matter has been added.

#### **Objections to the Specification**

The specification is objected to because it contains an embedded hyperlink and/or other form of browser-executable code (see pages 18, 21, and 27). Office Action at page 3.

Applicant has amended the specification to delete embedded hyperlinks and/or other forms of browser-executable code. Accordingly, withdrawal of this objection is respectfully requested.

#### **Claim Objections**

Claim 13 is objected to because of the following informalities: a hyphen should be inserted between the words "granulocyte" and "selective" in line 2. Office Action at page 3.

Applicant has amended claim 13 to include a hyphen. For consistency, hyphens have also been introduced into claim 14. Accordingly, withdrawal of this objection is respectfully requested.

#### **Rejections under 35 U.S.C. §112**

Claims 1-6 and 9-16 are rejected under 35 U.S. C. §112, first paragraph, because, according to the Examiner, the specification, while being enabling for a method of detecting statistically significant differences in the mRNA expression pattern observed between normal, healthy mammalian subjects and mammalian subjects known to possess a granulocyte disorder, does not reasonably provide enablement for diagnosing any granulocyte disorder in any biological sample

obtained from any subject based solely on the mRNA expression level of a single granulocyte-selective marker. Office Action at pages 3-4.

Without conceding the correctness of the Examiner's position, Applicant has amended independent claims 1 and 14 to recite the term "detecting the presence of" instead of "diagnosing". Claims 1 and 14 as currently amended are drawn to detecting the presence of a granulocyte disorder in a subject based on a statistically significant difference in the expression level of at least one of the disclosed granulocyte-selective marker in the subject as compared to a reference level.

Accordingly, withdrawal of the rejection under 35 U.S.C. §112 is respectfully requested.

Claims 1-6 and 9-16 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner states that the relation between the "reference level" and the "expected level" of expression is unclear. Office Action at page 9.

Applicant has amended independent claims 1, 9, 10, and 14 to clarify the claim language.

Accordingly, withdrawal of the rejection of claims 1-6 and 9-16 under 35 U.S.C. §112 is respectfully requested.

#### Rejections Under 35 U.S.C. §102

Claims 1, 2, 4-6, 9, 11, and 13-15 are rejected under 35 U.S.C. §102 as being anticipated by Yawalker et al. (Journal of Investigative Dermatology (1999) 113: 43-48). The Examiner alleges that Yawalker discloses the use of the granulocyte-selective marker CCR3 in the diagnosis of atopic dermatitis, which, according to the Examiner, is a basophil disorder. Office Action at page 10.

Without conceding the correctness of the Examiners position, Applicant has amended claims 1 and 14 to recite specific granulocyte-selective markers. CCR3 is not recited in the claims as currently amended.

Accordingly, withdrawal of this rejection is respectfully requested.

Claims 1-6, 10, 12, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Csiszar et al. (Clinical and Experimental Immunology (2000) 122: 464-470) as evidenced by

Claims 1-6, 10, 12, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Csiszar et al. (Clinical and Experimental Immunology (2000) 122: 464-470) as evidenced by Courtney et al. (Annals of the rheumatic Diseases (1999) 58: 309-314). The Examiner alleges that Csiszar discloses the use of the granulocyte-selective marker IL-4 in the diagnosis of SLE, which, according to the Examiner, is a granulocyte disorder. Office Action at page 11.

Without conceding the correctness of the Examiners position, Applicant has amended claim 1 to recite specific granulocyte-selective markers. IL-4 is not recited in the claim as currently amended.

Accordingly, withdrawal of this rejection is respectfully requested.

Claims 1-5, 10, 11 and 13-16 are rejected under 35 U.S.C. 102(a) as being unpatentable over Nowicki et al. (Oncogene (June 2003) 22: 3952-3963). The Examiner alleges that Nowicki discloses the use of the granulocyte-selective marker carbonic anhydrase IV in the diagnosis of chronic myelogenous leukemia, which, according to the Examiner, is a basophil disorder. Office Action at page 12.

Without conceding the correctness of the Examiners position, Applicant has amended claims 1 and 14 to recite specific granulocyte-selective markers. Carbonic anhydrase IV is not recited in the claims as currently amended.

Accordingly, withdrawal of this rejection is respectfully requested.

Claim 49 is rejected under 35 U.S. C. 102(b) as being anticipated by Schroeder et al. (Clinical and Experimental Allergy (2001) 31: 1369-1377). Office Action at page 13.

Without conceding the correctness of the Examiners position, Applicant has amended claims 49 to recite specific granulocyte-selective markers. The markers disclosed in Schroeder, IL-3 and IL-4, are not recited in the claim as currently amended.

Accordingly, withdrawal of this rejection is respectfully requested.

**CONCLUSION**

A Notice of Allowance is respectfully requested. The Examiner is requested to call the undersigned at the telephone number listed below if this communication does not place the case in condition for allowance.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, the Director is hereby authorized to charge any deficiency or credit any overpayment in the fees filed, asserted to be filed or which should have been filed herewith to our Deposit Account No. 23/2825, under Docket No. A0852.70000US01.

Dated: February 1, 2011

Respectfully submitted,

By

  
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